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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,963	10/06/2003	Gene Mason	MASIMO.353A	3580
20995	7590	06/02/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			KREMER, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/679,963	MASON, GENE	
	Examiner	Art Unit	
	Matthew J Kremer	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02272004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 9-10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 9-10 depend from claim 1, which is directed to an attachment device "for positioning a reflective optical probe to a measurement site," but claims 9-10 only include limitations on the optical probe. These additional limitations in claims 9-10 do not provide any structural on the claimed invention of the attachment device and therefore do not further limit the subject matter of claim 1.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,061,584 to Lovejoy et al. (Lovejoy). Lovejoy teaches a device that includes an attachment mechanism 46 that has a slot 58. (Fig. 1 of Lovejoy). The slot is capable of receiving a positioning member 39. (Fig. 1 of Lovejoy). The attachment

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device is configured in a way that when the optical probe is placed on the measurement site, the optical probe has protruding portions 16 and 18 that noninvasively recesses into the tissue at the measurement site. It is noted that the limitation "for positioning a reflective optical probe" was not given any patentable weight since this is merely "intended use" language, which cannot be relied upon to define over Lovejoy, since Lovejoy discloses all of the claimed elements of the attachment device and their recited relationships. See *Ex parte Masham* 2 USPQ 2nd 1647. In regard to claim 8, adhesive tape is used. (column 2, lines 55-61 of Lovejoy). In regard to claim 9, the probe can be selected for particular measurement sites. (column 3, lines 2-5 of Lovejoy). In regard to claim 10, the optical probe includes emitters 22 and 24. (Fig. 3 of Lovejoy).

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,802,485 to Bowers et al. (Bowers). Bowers teaches a device that includes an attachment mechanism 40 that has a slot at snap 54. (Fig. 3 of Bowers). The slot is capable of receiving a positioning member from sensor 18 at snap 54. (Fig. 3 of Bowers). The attachment device is configured in a way that when the optical probe is placed on the measurement site, the optical probe has a protruding portion 18 that noninvasively recesses into the tissue at the measurement site. In regard to claims 2-4, a biasing member 52 is disclosed (Fig. 3 of Bowers). In regard to claim 5, attachment device 40 is a headband. In regard to claims 6-7, ruler-like indicia are disclosed (reference number 44 in Fig. 3 of Bowers).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,380,240 to Jobsis et al. (Jobsis) in view of U.S. Patent 6,061,584 to Lovejoy et al. (Lovejoy). Jobsis teaches an attachment mechanism 150 and a reflective probe 155 that has one protruding portion 156 that noninvasively recesses into tissue at the measurement site. Jobsis teaches that the reflective probe 155 is secured to the attachment mechanism 150 (column 8, lines 2-12 of Jobsis) but Jobsis does not teach how this is accomplished. Lovejoy teaches a positioning and slot system (see reference numerals 39,40, 58, and 59 in Fig. 1 of Lovejoy) that would fulfill the requirements of providing the secure attachment of the probe 155 to that attachment mechanism 150 as set forth in Jobsis. (Fig. 1 of Lovejoy). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the positioning and slot system as disclosed by Lovejoy in the device of Jobsis since Jobsis teaches that the reflective probe 155 is secured to the attachment mechanism 150 and Lovejoy teaches how this can be accomplished. In regard to claim 5, the attachment mechanism is a headband since the device is used on the head. (Abstract of Jobsis). In

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regard to claim 9, the probe can be selected for particular measurement sites. (Abstract of Jobsis).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 703-605-0421. The examiner can normally be reached on Mon. through Fri. between 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703-308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Kremer
Assistant Examiner
Art Unit 3736



MARY BETH JONES
ACTING SUPERVISORY PATENT EXAMINER